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OFFICE OF PETITIONS

In re Application of
William B. Parker et al
Application No. 10/657,451
Filed: September 8, 2003
Attorney Docket No. B6603-0003

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:DECISION ON PETITIONS
:UNDER 37 CFR 1.78(a)(3)
:AND 37 CFR 1.78(a)(6)
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed April 14, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of prior-filed nonprovisional Application No. 08/972,464, filed November 14, 1997.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

The petition was accompanied by an amendment to the first sentence of the specification following the title to include a reference to the above-noted, prior-filed application, as well as to provisional Application No. 60/030,962.

This nonprovisional application was filed on September 8, 2003, and was pending at the time of filing of this petition. While a reference to the prior-filed application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with this application.

The current procedure where a claim for priority under 37 CFR § 1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(2)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR §

1.78(a)(3).¹ In the instant case, the Office noted the claim for priority of prior-filed Application No. 08/972,464 in the transmittal letter filed with the application, as shown by its inclusion on the filing receipt.


In view of the above, the \$1,370 petition fee submitted is unnecessary and will be refunded to petitioner's credit card.

It is noted that the amendment to the claim for priority to prior-filed Application No. 08/972,464 submitted with the petition fails to set forth the relationship of that application to the present application; i.e., the amendment merely states that "This application claims the benefit of U.S. Patent Application 08/972,464 * * *." The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-art of a prior-filed nonprovisional application.

Petitioner is reminded that, even if the Office has recognized a benefit claim by entering it into the Office's database and including it on applicant's filing receipt, the benefit claim is not a proper benefit claim under 35 U.S.C. § 120 and 37 CFR 1.78 unless the reference is included in an ADS or in the first sentence of the specification and all other requirements are met. *Note* MPEP § 201.11 D. Reference Must Be Included in the Specification or an Application Data Sheet.

Any questions concerning this decision on petition may be directed to Irvin Dingle at (571) 272-3210. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center AU 2872 for appropriate action as the nature of the case may require.


Frances Hicks
Petitions Examiner
Office of Petitions

¹ *Note* MPEP 201.11 (III)(D), pages 200-59 and 200-60 (Rev. 2. May 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.